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In re Application of
MOLEV-SHTEIMAN
Serial No.: 09/529,163
PCT No.: PCT/US98/19708
Int. Filing Date: 18 September 1998
Priority Date: 09 October 1997
Attorney Docket No.: 968/32
For: METHOD OF EMULATING A
SHIFT REGISTER USING A RAM

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: DECISION ON PETITION
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: TO WITHDRAW HOLDING
:
: OF ABANDONMENT
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This decision is in response to applicant's "Renewed Petition under 37 CFR 1.181", filed 09 October 2001 in the United States Patent and Trademark Office (USPTO) in the above-captioned application, requesting withdrawal of the holding of abandonment. No petition fee is required.

BACKGROUND

On 17 May 2000, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration and the appropriate surcharge for filing the oath or declaration after the thirty month period was required.

On 23 January 2001, a Notification of Abandonment was mailed to applicant indicating that applicant had failed to respond to the 17 May 2000 Notification of Missing Requirements.

On 09 February 2001, applicant filed a "Petition to Withdraw Holding of Abandonment" seeking withdrawal of the holding of abandonment and alleging that the Notification of Missing Requirements mailed 17 May 2000 was never received, that no response was made and the application went abandoned. The petition was treated as a petition to withdraw the holding of abandonment under 37 CFR 1.181.

On 10 August 2001, a decision dismissing the petition was mailed to applicant indicating that applicant had failed to provide a proper showing to establish that papers were not received.

On 09 October 2001, applicant filed the instant renewed petition under 37 CFR 1.181 along with the revised declarations of Mark M. Friedman and Anthony Castorina.

DISCUSSION

As stated in the decision mailed 10 August 2001, a petition requesting relief based on the grounds that an Office action was not received as set forth in the Official Gazette at 1156 OG 53 must be accompanied by the following: (1) a statement by the practitioner stating that the Office

action was not received by the practitioner and (2) attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received; (3) a copy of the docket record where the non-received Office action would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. (See also Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971) and as set forth in the Official Gazette at 1156 OG 53.)

Attorney for applicant, Mark Friedman, previously indicated that attorney Anthony J. Castorina receives all correspondence addressed to him from the USPTO. The instant renewed petition is accompanied by revised declarations of Messrs. Friedman and Castorina.

In his October 4, 2001 declaration, Mr. Friedman attests that he has "searched the file jacket and docket records, and these indicate that the Office Action was not received." Mr. Friedman has now provided a statement stating that the Office action was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. Mr. Friedman's statement satisfies Items (1) and (2) above.

With regard to item (3), Mr. Friedman declares that he has "reviewed the database of all actions docketed -copies of new entries entered in the database between Jan. 21, 2001 and Feb. 7, 2001 enclosed herein. No entry for docketing a Notice of Missing Requirements or any other USPTO action appears with respect to this application".

Mr. Friedman does not state that the docket record provided is "a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed" as required. Mr. Friedman also has not provided any explanation of the entries in the docket record. He gives no explanation of what this docket represents or how to decipher its contents or how this record demonstrates that the 17 May 2002 Notification of Missing Requirements was never received by applicant. It is not evident on its face what this record represents.

Finally, Mr. Friedman's declaration indicates that the entries in the docket submitted are for a time period, **between January 21, 2001 and February 7, 2001**. This is not the time period under scrutiny.

With regard to Mr. Castorina's declaration, the declaration is unsigned and thus, cannot be considered in reviewing the renewed petition. It is further noted that paragraph 5 of the declaration indicates that "there is no record indicating receipt of USPTO actions that had a response due date of **July 17, 2000**." (Emphasis added.) The response due date in question in the instant application is June 17, 2000.

Mr. Castorina submitted a copy of a mail log showing correspondence received from the United States Patent and Trademark Office as it was received (May 1-31 and June 1-23, 2000). Mr. Castorina's log is not the docketing system used to indicate correspondence with a response due date of 17 June 2000 but represents a mail log of correspondence received. The submitted docket record must show all responses due on 17 June 2000. Since the evidence is a mail log, the log for subsequent weeks maybe helpful in demonstrating non-receipt of the Office action mailed on 17 May 2000. Thus, Mr. Castorina's declaration fails to provide the proper showing necessary to withdraw the holding of abandonment and thus, the petition may not be properly granted.

What is required is a copy of the attorney of record, Mr. Friedman's docket record showing all responses docketed for the date the response was due (17 June 2000 in this case)

showing that there was no record of a response for the present application being due on that date. This docket record must be attached to and referenced in practitioner's statement.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions). See MPEP section 711.03(c).

CONCLUSION

The Notification of Abandonment mailed on 23 January 2001 remains in effect.

Applicant's renewed petition under 37 CFR 1.181 to request to withdraw holding of abandonment is **DISMISSED WITHOUT PREJUDICE**.

Applicant has TWO (2) months to file a response. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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